



BAKER BOTTS LLP

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OCT 29 2004

OFFICE OF PETITIONS

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)	Docket Number (Optional) 34089-PCT-USA
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First named inventor: Sawhill

Application No.: 09/786,740 Art Unit: unassigned

Filed: March 8, 2001 Examiner: unassigned

Title: INTERFACE DEVICE BETWEEN TESTING EQUIPMENT AND INTEGRATED CIRCUIT

Attention: Office of Petitions
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee --required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☒ Small entity-fee \$ 685 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee \$ _____ (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of Petition (identify type of reply):

☐ has been filed previously on _____

☒ is enclosed herewith.

B. The issue fee of \$ _____

☐ has been paid previously on _____

☐ is enclosed herewith.

[Page 1 of 2]

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685.00 OP

3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE. The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D))].

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

October 21, 2004
Date


Signature

Telephone
Number: 212.408.2584

David Loretto
Typed or printed name

Address

Enclosures: ☒ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☒ Additional sheets containing statements establishing unintentional delay (Exhibits A-H)

☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☒ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450 Alexandria, VA 22313-1450

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 308-6916.

October 21, 2004
Date


Signature

David Loretto
Type or printed name of person signing certificate



A34089 PCT USA-069354.0101

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Sawhill and Shah
Serial No. : 09/786,740 Examiner : Unassigned
Filed : March 8, 2001 Group Art Unit : Unassigned
For : INTERFACE DEVICE BETWEEN TESTING EQUIPMENT
AND INTEGRATED CIRCUIT

**PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR
PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY
UNDER 37 C.F.R. § 1.317(b)**

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OFFICE OF PETITIONS

October 21, 2004

Date of Deposit

David Loretto

Attorney Name

David Loretto

Signature

44,374

PTO Reg. No.

October 21, 2004

Date of Signature

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Attention: Mail Stop PCT

Sir:

Applicant respectfully submits this petition under 37 C.F.R. § 1.137(b) to
revive unintentionally abandoned PCT Application No. 09/786,740 designating the
United States. The entire delay in filing the required reply from the due date for the reply
until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional.

Because the mailing date of this petition is more than one year after the date of abandonment, April 25, 2003, pursuant to MPEP § 711.03(c)(D), this petition contains further information regarding (A) when applicant (or applicant's representatives) became aware of the abandonment and (B) a showing that the delay in discovering the abandonment occurred despite the exercise of due care or diligence on the part of applicant (or applicant's representatives). A statement of the facts is provided to facilitate the consideration of this petition.

1. STATEMENT OF FACTS

On September 9, 1998, Spire Technologies Private Limited ("Spire") submitted International Application No. PCT/SG98/0068 in Singapore. The application named Spire employees Robert Arthur Sawhill Jr. ("Sawhill") and Paren Indravedan Shah (Shah") as co-inventors and was filed by applicant's Singaporean representative, Lloyd Wise.

On March 8, 2001, a submission for entry into the national stage in the United States was filed by applicant's U.S. representative, Baker Botts.

On April 23, 2001, the PTO mailed a notice to Baker Botts indicating that the oath or declaration required under 37 C.F.R. §§ 1.497(a) and (b) was missing from the March 8, 2001, submission for entry into the national stage.

On October 23, 2001, Baker Botts submitted a Petition Under 37 C.F.R. § 1.47(a), including, in lieu of Shah's signed declaration, a Declaration Under 37 C.F.R. §

1.47(a) in which Sawhill declared that he had been unable to locate his co-inventor Shah, since Shah had left Spire for an unknown location in California.

On December 6, 2001, the PTO sent a Notice of Abandonment to Baker Botts, which was later withdrawn upon resubmission of the October 23, 2001, Petition Under 37 C.F.R. § 1.47(a).

On February 11, 2002, the PTO Office of PCT Legal Administration dismissed the October 23, 2001, petition, without prejudice, on the ground that Sawhill's Declaration Under 37 C.F.R. § 1.47(a) did not describe in sufficient detail the facts relied upon to establish that Sawhill had made a diligent effort to locate his co-inventor Shah, as required by MPEP § 409.03(D).

On July 3, 2002, Baker Botts submitted a second Petition Under 37 C.F.R. § 1.47(a), which included a second Sawhill Declaration Under 37 C.F.R. § 1.47(a), copies of e-mails sent between Sawhill, Shah and Lloyd Wise attorney Timothy Watkin, during May 2002, and a copy of Shah's October 1998 employment agreement with Spire. In his second declaration, Sawhill explained that he had forwarded new declaration and assignment documents to Shah in California, but that Shah had told him that he would not sign without receipt of monetary compensation.

On October 25, 2002, the PTO Office of PCT Legal Administration dismissed, without prejudice, applicant's second Petition Under 37 C.F.R. § 1.47(a), on the grounds that the text of the May 2002 e-mails indicated (1) Shah's refusal to sign may have been based solely on his unwillingness to assign ownership to Spire and (2) Sawhill's declaration may contain Shah's incorrect address and nationality.

On March 18, 2003, Baker Botts attorney Michael J. McNamara mailed a newly prepared combined declaration/power of attorney together with a copy of the application to Shah and requested that Shah review the application and sign and return the declaration to Baker Botts.

On April 25, 2003, no response having been filed to the October 25, 2002, dismissal of the Petition Under 37 C.F.R. § 1.47(a), the application became abandoned as a matter of law.

In June 2004, the status of the file was reviewed and it was determined that the file had become abandoned. Applicants representatives then undertook an investigation into the likely cause of the unintentional abandonment. Once it had been established that the abandonment had occurred despite the exercise of due care or diligence, the present Petition Under 37 C.F.R. § 1.317(b) was prepared.

2. ADDITIONAL INFORMATION REQUIRED UNDER MPEP § 711.03(C)(D)

Because the mailing date of the present petition is more than one year after the date of abandonment, April 25, 2003, pursuant to MPEP § 711.03(c)(D), information is hereby submitted regarding (A) when applicant (or applicant's representatives) became aware of the abandonment and (B) to show that the delay in discovering the abandonment occurred despite the exercise of due care or diligence on the part of applicant (or applicant's representatives).

A. Applicant and Applicant's Representative First Learned of the Abandonment in June 2004

The unintentional abandonment was discovered when applicant's representative Baker Botts reviewed the status of the application in June 2004.

B. The Delay in Discovering the Abandonment of the Application Occurred Despite the Exercise of Due Care or Diligence on the Part of Applicant or Applicant's Representatives

Based upon an investigation of the events that gave rise to the abandonment, it appears that the April 25, 2003, six-month deadline passed without notice because no Notice of Abandonment was received by Baker Botts. In addition, an administrative error led to the status of the file not being reviewed by applicant's representatives before the date of abandonment as a matter of law. In any event, in the absence of a Notice of Abandonment, the mere lack of any office communication between April 2003 and June 2004 did not put applicant or applicant's representatives on notice that the application had become unintentionally abandoned.

3. CONCLUSION

For the reasons given above, applicant respectfully submits that the abandonment of U.S. Application No. 09/786,740 by action of law on April 25, 2003,

was unintentional and remained undiscovered until June 2004, despite the exercise of due care or diligence on the part of applicant or applicant's representatives. Accordingly, applicant respectfully requests that this petition under 37 C.F.R. §1.137(b) be granted.

In addition to the fee set forth in 37 C.F.R. § 1.17(m), applicant is not aware that any further fee is required in connection with the present petition. In the event that an additional fee is required, the Commissioner is authorized to charge Deposit Account No. 02-4377.

Respectfully submitted,

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